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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,280	07/10/2001	Srinivas Venkatram	117.011	1527

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EXAMINER

BOOKER, KELVIN E

ART UNIT	PAPER NUMBER
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2121

DATE MAILED: 12/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/902,280

Applicant(s)

VENKATRAM, SRINIVAS

Examiner

Kelvin E Booker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Detailed Office Action*.

DETAILED ACTION

Response to Amendment

1. In Preliminary Amendment "A", filed August 2, 2001 (see paper no. 2), **claim 6** has been amended. **Claims 1-6** are presented for examination.

Claim Objections

2. **Claim 2** is objected to because the dependent claim depends upon itself. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 5 and 6** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the functionality used to link the claimed elements. The aforementioned claim is directed to a system for executing a process, whereby only three

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elements of the system is claimed, without rendering any functional and/or relational ties to the system or each other.

Claim Rejections - 35 USC § 101

5. **Claims 5 and 6** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. While the claims are in the technological arts, they are not limited to practical applications in the technological arts.

Specifically, the claims are directed toward a series of steps to be performed on a computer system, but the ideas are disclosed abstractly from any particular practical application. **Claim 5** focuses on elements of a system for executing sales transactions, however the claims fail to define a statutory specific system. A machine or manufacture or system claim may be one of two types: (1) a claim that encompasses any and every machine for performing the underlying process or any and every manufacture that can cause a computer to perform the underlying process, or (2) a claim that defines a specific machine or manufacture. When a claim is of the first type, Office personnel are to evaluate the underlying process the computer will perform in order to determine the patentability of the product.

The mere fact that a hardware element is recited in the claim does not necessarily limit the claim to a specific machine or manufacture. If a product claim encompasses any and every computer implementation of a process, when read in light of the specification, it should be examined on the basis of the underlying process. Such a claim can be recognized, as it will define the physical characteristics of a computer or computer component exclusively as functions

or steps to be performed on or by a computer, and encompass any and every product in the stated class, configured in any manner to perform the process.

Claims that define a computer related invention as a specific machine or specific article of manufacture must define the physical structure of the machine or manufacture in terms of its hardware or hardware and "specific software." The applicant may define the physical structure of a programmed computer or its hardware or software components in any manner that can be clearly understood by a person skilled in the relevant art. Generally a claim drawn to a particular programmed computer should identify the elements of the computer and indicate how those elements are configured in either hardware or a combination of hardware and specific software.

Further, to constitutionally interpret the word "process", the Supreme Court has held that: "***A process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject matter to be transformed and reduced to a different state or thing. ***The Process requires that certain things should be done with certain substances, and in a certain order; but the tools to be used in doing this may be a secondary consequence."(emphasis added) *Diamond, Commission of Patents and Trademarks v. Diehr and Lutton*, 209 USPQ 1, 6 (1981) quoting *Cochrane v. Deener*, 94 U.S. 780, 787-788 (1876).

This Constitutional interpretation of the word "process" is a long-standing one that the Supreme Court requires to be applied in interpreting 35 USC 101. *Diamond v. Diehr* at 6. Consequently, the use of that interpretation is Constitutionally required when we interpret the Federal Circuit's standard that a "new and useful process" is one that produces a useful, concrete, and tangible result". Cf. *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 47 USPQ2d 1596, 1600-1601 (Fed. Cir. 1998).

Applicant discloses no “certain substances” that have been “transformed or reduced” in that applicant’s claims disclose no specific computer-readable medium, no manipulation of specific data representing physical objects or activities (pre-computer activity), nor do they disclose any specific independent physical acts being performed by the invention (post-computer activity).

Claim 6 does not cure the defect in the **claim 5**. On this basis, **claims 5 and 6** are rejected under 35 USC 101.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-6 are rejected under 35 U.S.C. 102(a) as being anticipated by Hazlehurst et al., U.S. Patent No. 6,003,020 [hereafter Hazlehurst].

As per claim 1, Hazlehurst teaches of a system for retrieving relevant goal-optimal ordered knowledge, said system comprising:

A. a navigation and user directive system (see figure 2, element 32 and figure 4, element 60: interactive user-directive functionality);

B. A set of knowledge structures and engines used to embed content and re-aggregate content around the goal-oriented structures (see figure 2, elements 10 and 30; and column 3, line 36 through column 4, line 25);

C. a framework for capturing and processing data across a goal-community (see column 3, lines 48-55: "The knowledge base...machine-readable databases); and

D. a framework to organize knowledge mining for a broader practice-community (see column 3, lines 36-47: "The user data tank...database management systems(DBMS)").

As per claim 2, Hazlehurst teaches of a system wherein the system includes a set of access portals, an information addressing system or access intelligence engine linking to the universe of information (see column 4, lines 13-25: "The intelligent profiling system...profiling engine 22").

As per claim 3, Hazlehurst teaches of a system wherein the knowledge structures and, engines are used to tag data available to an organization on the basis of a universal classification system (see column 3, lines 57-65: "the inference engine...liaison 34 to user 32").

As per claim 4, Hazlehurst teaches of a system wherein the framework to organize knowledge for a broader practice community, includes a network of personal portals enabling each user to have personal access (see column 1, line 66 through column 2, line 8: "Data collection is managed...clinical patient record").

As per claim 5, Hazlehurst teaches of a system for executing transactions, said system comprising of

a) a personal knowledge portal (see figure 2; and column 1, line 66 through column 2, line 8);

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b) a domain specific retrieval engine (see column 4, lines 13-25: "the intelligent profiling system...a profiling engine"); and

c) a knowledge service provider (see column 2, lines 10-16: "the system utilizes...by the system).

As per claim 6, Hazlehurst teaches of a system further comprising an access screen framework, the framework providing real intelligence, a set of relevant documents in response to a seeker's request (see figures 4 and 10; and column 5, lines 59-64: "Fig. 10 shows...about the user").

Conclusion

7. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

A. Venkatram, U.S. Patent Application Publication No. 2002/0049750;

B. Venkatram, U.S. Patent Application Publication No. 2002/0049689;

C. Stier et al., U.S. Patent No. 6,493,697;

D. Stier et al., U.S. Patent No. 6,499,024;

E. Stier et al., U.S. Patent No. 6,560,589;

F. Stier et al., U.S. Patent No. 6,591,258;

G. Wical, U.S. Patent No. 6,061,675;

H. Wical, U.S. Patent No. 6,487,545; and

I. Tsuruta et al., U.S. Patent No. 5,299,287.

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8. An inquiry concerning this communication or earlier communications from the examiner should be directed to Kelvin Booker whose telephone number is (703) 308-4088. The examiner can normally be reached on Monday-Friday from 7:00 AM-5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anil Khatri, can be reached on (703) 305-0282. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

An inquiry of a general nature or relating to the status of this application proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

K.E.B.

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December 2, 2003



ANIL KHATRI
SUPERVISORY PATENT EXAMINER